

In re Application of RAMAKRISHNA et al.
Serial No. 09/316,897

REMARKS

The Office action has been carefully considered. The Office action rejected claims 1-7, 10-19, and 21-25, 27-39, and 43-47 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,907,704 to Gudmundson et al. ("Gudmundson"). Further, the Office action rejected claims 8 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Gudmundson in view of U.S. Patent No. 6,085,220 to Courts et al. ("Courts"). Further yet, the Office action rejected claims 9, 26, and 40-42 under 35 U.S.C. § 103(a) as being unpatentable over Gudmundson in view of U.S. Patent No. 6,230,171 to Pacifici et al. ("Pacifici"). Finally, the Office action rejected claims 17-47 under 35 U.S.C. § 112, second paragraph for lack of antecedent basis and objected to the abstract for being longer than 150 words. Applicants have amended the abstract and claims 17 and 30 to obviate the rejections based on § 112. Regarding the other rejections, applicants respectfully disagree.

By present amendment, claims 1, 17, and 30 have been amended for clarification and not in view of the prior art. Applicants submit that the claims as filed were patentable over the prior art of record, and that the amendments herein are for purposes of clarifying the claims and/or for expediting allowance of the claims and not for reasons related to patentability. Reconsideration is respectfully requested.

Applicants thank the Examiner for the interview held (by telephone) on November 5, 2004. During the interview, the Examiner and applicants' attorney

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discussed the claims with respect to the prior art. The essence of applicants' position is incorporated in the remarks below.

Prior to discussing reasons why applicants believe that the claims in this application are clearly allowable in view of the teachings of the cited and applied references, a brief description of the present invention is presented.

The present invention is directed, generally, towards behaviors of elements in a document, in which an encapsulated component (e.g., object), external to the document, may be invoked to change the behavior (e.g., effects such as style, behavior, and/or display) of the associated element in the document. That is, the current content (elements) of the document may be modified by effects (behaviors). The associations between elements and external behavior components may be maintained in cascading style sheets, inline with the elements, and/or in various formats. When the document is provided to a renderer and the renderer parses the element in the document, the renderer may access the associated external component to modify a behavior of the page image, by running code such as script-based code.

Further, each behavior component may be external to the document and its content. As a result, for example, a library of consistent, reusable behaviors may be defined and made available for use in designing and authoring many different web pages with different content. Similar to a library of functions, the same behavior component can be invoked as needed from different documents and may be simultaneously interfaced with elements from different documents consistently, without requiring customization and so forth. Thus, not only may a single behavior

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be shared among elements of a document, but a behavior component may also be reused across other documents.

Note that the above description is for example and informational purposes only, and should not be used to interpret the claims, which are discussed below.

Turning to the claims, amended claim 1 recites a computer-readable medium having computer-executable instructions, comprising, receiving a document having an element thereon, the document including information associating the element with an external component that is encapsulated and external to the document such that the external component may be used simultaneously with a plurality of different documents including the document having the element thereon, rendering a page image corresponding to at least part of the document, the page image including a representation of the element; and accessing the external component for determining a behavior of the representation of the element rendered on the page image.

The Office action rejected claim 1 as being unpatentable over Gudmundson. The Office action contends that Gudmundson teaches the recitations of claim 1 and subsequently refers to the rejection of claim 17 for the specific references to Gudmundson. More specifically, the Office action contends that Gudmundson teaches encapsulating code in an external component for affecting the behavior of elements including elements of different documents. Column 9, lines 1-39 of Gudmundson is referenced. Further, the Office action contends that Gudmundson teaches inserting an element into a document and providing the document to a renderer. Column 11, lines 8-21 of Gudmundson is referenced. Still further, the

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Office action contends that Gudmundson teaches rendering a page image corresponding to at least part of the document, the page image including a representation of the element, and accessing the external component for determining a behavior of the representation of the element rendered on the page image. Column 13, lines 24-59, and column 8, lines 39-45 of Gudmundson are referenced. The Office action does acknowledge that Gudmundson does not teach attaching a reference to the document. However, the Office action contends this recitation would have been obvious to a person skilled in the art at the time the invention was made because the teachings of Gudmundson are easily modified to allow the element in the document to possess certain inherent characteristics relating to that external component. Applicants respectfully disagree.

To establish *prima facie* obviousness of a claimed invention, all of the claim recitations must be taught or suggested by the prior art; (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)), and "all words in a claim must be considered in judging the patentability of that claim against the prior art;" (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). Moreover, if a modification would render a reference unsatisfactory for its intended purpose, the suggested modification / combination is impermissible. See MPEP § 2143.01

In general, Gudmundson teaches a method and system for authoring multimedia titles having the ability to traverse environments. In specific,

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Gudmundson teaches a method for using encapsulated objects that are programmed to be free of environment variables such that the objects may be freely linked to different elements and transported to elements in any environment. To do so, certain behavior elements may be encapsulated as an object that may be transported and attached to other objects, object containers, modifiers and/or elements.

For example, an encapsulated object in Gudmundson may encode a behavior for presenting a pop-up menu when a pointing device "mouses over" an element, *i.e.*, a picture. Thus, the encapsulated object (*i.e.*, the behavior) itself is transported to the environment of the element and linked to the element through object inheritance. The element itself contains the necessary code that the encapsulated object needs in order to render a pop-up menu in the environment of the element. Then, if the encapsulated object is needed elsewhere, it is unlinked from the element, transported to a different environment and then linked to a different element in the different environment. Thus, the encapsulated object is reused in a different environment, but may only be used in one environment at a time since the encapsulated object must remain linked with the element in order to use the environment variables known only to the element.

Quite differently, the present invention is directed to a method and system for simultaneously providing an external behavior component to a plurality of documents. For example, a library of consistent, reusable behaviors may be defined and made available for use in designing and authoring many different web pages with different content. Similar to a library of functions, the same behavior

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component may be invoked as needed from different documents and simultaneously interfaced with consistently. Thus, not only may a single behavior be shared among elements of one document, but a behavior component may be simultaneously reused across elements in other documents.

Applicants submit that the Office action has failed to establish *prima facie* obviousness as a matter of law with respect to the claimed subject matter. Specifically, amended claim 1 recites receiving a document having an element thereon, the document including information associating the element with an external component that is encapsulated and external to the document such that the external component may be used simultaneously with a plurality of different documents including the document having the element thereon. As discussed above, Gudmundson teaches providing an encapsulated element that may be reused across different environments. An encapsulated behavior element that is reused in different environments is not the same as an external component may be used simultaneously with a plurality of different documents. Being only concerned with different environments, Gudmundson simply does not teach or even suggest the concept of an encapsulated elements having the ability to be simultaneous used by different elements in different documents. Further, if anything, Gudmundson teaches away from the present invention in that the encapsulated element necessarily requires additional variables provided by a linked element in order to function correctly. Thus, the encapsulated element cannot possibly be used by another element because the variables provided to the encapsulated element by two different elements would conflict with each other.

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For at least these reasons, applicants submit that claim 1 is patentable over Gudmundson whether considered alone or in any permissible combination of any prior art of record.

Applicants respectfully submit that dependent claims 2-16, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 1 and consequently includes the recitations of independent claim 1. As discussed above, Gudmundson, whether considered alone or in any permissible combination, fails to teach or suggest the recitations of claim 1 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 1 noted above, each of these dependent claims includes additional patentable elements.

For example, claim 8 recites the external component comprises a COM object, and wherein accessing the external component for determining a behavior of the representation of the other element includes accessing another instance of the object. The Office action acknowledges that Gudmundson does not teach a COM object, but contends that Courts does teach a COM object and the combination of the teachings of Gudmundson and Courts would render the recitations of claim 8 obvious. Applicants respectfully disagree and point out again that Gudmundson does not show any appreciation or understanding of object instantiation and/or simultaneous sharing of encapsulated components and consequently fails to teach or suggest the recitations of claim 8.

Turning to the next independent claim, amended claim 17 recites a method of providing dynamic effects to an HTML document, comprising, encapsulating

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code in an external component that may simultaneously affect the behavior of one or more elements, including elements of different documents, inserting an element into a document, attaching a reference in the document to associate the element with the external component, and providing the document to a renderer.

The Office action rejected claim 17 as being unpatentable over Gudmundson. More specifically, the Office action contends that Gudmundson teaches encapsulating code in an external component for affecting the behavior of elements including elements of different documents. Column 9, lines 1-39 of Gudmundson is referenced. Further, the Office action contends that Gudmundson teaches inserting an element into a document and providing the document to a renderer. Column 11, lines 8-21 of Gudmundson is referenced. The Office action does acknowledge that Gudmundson does not teach attaching a reference to the document. However, the Office action contends this recitation would have been obvious to a person skilled in the art at the time the invention was made because the teachings of Gudmundson are easily modified to allow the element in the document to possess certain inherent characteristics relating to that to that external component. Applicants respectfully disagree.

As discussed above, the Office action has failed to establish *prima facie* obviousness as a matter of law with respect to any of the claimed subject matter. Specifically, claim 17 recites receiving a document having an element thereon, the document including information associating the element with an external component that is encapsulated and external to the document such that the external component may be used simultaneously with a plurality of different

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documents including the document having the element thereon. As discussed above, Gudmundson teaches providing an encapsulated element that may be reused across different environments. An encapsulated behavior element that may be reused in different environments is not the same as an external component may be used simultaneously with a plurality of different documents. Being only concerned with different environments, Gudmundson simply does not teach or even suggest the concept of an encapsulated elements having the ability to be simultaneous used by different elements in different documents.

For at least these reasons, applicants submit that claim 17 is patentable over Gudmundson whether considered alone or in any permissible combination of any prior art of record.

Applicants respectfully submit that dependent claims 18-29, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 17 and consequently includes the recitations of independent claim 17. As discussed above, Gudmundson, whether considered alone or in any permissible combination of the prior art of record, fails to teach or suggest the recitations of claim 17 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 17 noted above, each of these dependent claims includes additional patentable elements.

For example, claim 20 recites the external component is a COM object, and wherein accessing the external component includes calling an interface of the COM object. The Office action acknowledges that Gudmundson does not teach a COM object, but contends that Courts does teach a COM object and the

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combination of the teachings of Gudmundson and Courts would render the recitations of claim 20 obvious. Applicants respectfully disagree and point out again that Gudmundson does not show any appreciation or understanding of object instantiation and/or simultaneous sharing of encapsulated components and consequently fails to teach or suggest the recitations of claim 20.

Turning to the last independent claim, amended claim 30 recites in a computer system, a system for rendering page images on a display, comprising an external component encapsulating code for modifying the behavior of one or more elements, the external component operable to simultaneously modify elements in a plurality of different documents, including elements of different documents, and a renderer connected to the display for rendering page images, the renderer receiving a document having an element specified therein and information associating the element with the external component, the renderer rendering a page image corresponding to the document and accessing the external component for modifying the page image.

The Office action rejected claim 30 as being unpatentable over Gudmundson. The Office action contends that Gudmundson teaches the recitations of claim 30 and subsequently refers to the rejection of claims 1 and 17 for the specific cites to Gudmundson. Applicants respectfully disagree.

Again, as shown above, the Office action has failed to establish *prima facie* obviousness as a matter of law with respect to any of the claimed subject matter. Specifically, claim 30 recites an external component encapsulating code for modifying the behavior of one or more elements, the external component operable

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to simultaneously modify elements in a plurality of different documents, including elements of different documents. As discussed above, Gudmundson teaches providing an encapsulated element that may be reused across different environments. An encapsulated behavior element that may be reused in different environments is not the same as an external component may be used simultaneously with a plurality of different documents. Being only concerned with different environments, Gudmundson simply does not teach or even suggest the concept of an encapsulated elements having the ability to be simultaneous used by different elements in different documents.

For at least these reasons, applicants submit that claim 30 is patentable over Gudmundson whether considered alone or in any permissible combination of the prior art of record.

Applicants respectfully submit that dependent claims 31-47, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 30 and consequently includes the recitations of independent claim 30. As discussed above, Gudmundson, whether considered alone or in any permissible combination of the prior art of record, fails to teach or suggest the recitations of claim 30 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 30 noted above, each of these dependent claims includes additional patentable elements.

For at least these reasons, applicants submit that all the claims are patentable over the prior art of record. Reconsideration and withdrawal of the

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rejections in the Office action is respectfully requested and early allowance of this application is earnestly solicited.

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CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 1-47 are patentable over the prior art of record, and that the application is in good and proper form for allowance. A favorable action on the part of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 836-3030.

Respectfully submitted,



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